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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/038,235 | 10/19/2001 | Scott A. Rice | C01-02 | 7870 |

7590

07/01/2003

D. Michael Burns
Acushnet Company
333 Bridge Street
Fairhaven, MA 02719

EXAMINER

DUONG, THANH P

ART UNIT PAPER NUMBER

3711

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DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,235

Applicant(s)

RICE, SCOTT A.

Examiner

Tom P Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-18 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-18 and 21-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 5-18, and 21-29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallaway et al. (6,354,962). Regarding claims 1, 6-11, 13-15, and 17-23, Gallaway et al. discloses a golf club head 42, having a volume of 400cc, (Abstract) adapted to a shaft 48 comprising: a hollow body 46 welded to an oval shaped titanium face plate 72 (Col. 5, lines 51-65) or impact insert having a variable thickness ranging from 0.110-0.09 inch (Col. 8, lines 10-34); a body including a heel portion, a toe portion, a crown portion, a sole plate, skirt portion, a hosel 54 extended from heel portion, weighted elements 122 and 123, and face extension 74 (Figures 10 and 12-12a). The face extension 74 with 0.2-1.0 inch from the face plate (Col. 6, lines 39-44) includes an upper lateral extension 76 and a lower lateral extension 78. Such face extension is functionally equivalent to the transition junction. Regarding claim 5, it appears that the upper and lower lateral extension has a thickness sufficient to support the face plate 72 but thin enough to maximize COR. With respect to the method of fabricating the metal insert, Official Notice is taken that using stamped process to form the metal insert is old and well-known in the art. Regarding claim 8, it appears as shown in Figure 5 that the bulge face plate have at least two different radii for the

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exterior and interior. Regarding claim 12, Official Notice is taken that such titanium materials are known in the art and it would have obvious to use such material here to maximize club head strength and club head volume. Regarding claim 16, Official Notice is taken that it is known in the art to provide various loft angles and it would have been obvious to do so here to control spin rate and distance. With respect to the location of the weighted element, Callaway discloses that placing the weighted elements at various locations in the sole portion is art-recognized (Col. 7, lines 55-61) to improve center of gravity and moment of inertia. In addition, Official Notice is taken that USPN 4,471,961 and USPN 5,219,408 show weight members in the sole portion which have the features of the claimed invention. Claims 24-29 recite limitations similar to claims 1-23; thus, claims 24-29 are rejected for the same reasons as applied in claims 1-23, above.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1-27 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-27 of copending Application No. 10/047,321. This is a

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provisional double patenting rejection since the conflicting claims have not in fact been patented.

NOTE: The amendment filed on 4/11/03 indicates that the Applicant had filed an expressed abandonment for Application No. 10/047,321 to overcome the double patent rejection. However, the office has not received paper filed PTO Form SB/24 for an Express Abandonment under 37 CFR 1.138.

Response to Arguments

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

In response to arguments of claims 24-27, Applicant argues that Gallaway does not disclose an oval insert. Gallaway clearly shows a face plate or insert having an oval shape. In response to location of the weight element, Callaway discloses that placing the weighted element(s) at various locations in the sole portion is art-recognized within one skilled in the art (Col. 7, lines 55-61). In addition, Official Notice is taken that USPN 4,471,961 and USPN 5,219,408 show weight members in the sole portion rearward of the intersection of the hosel and sole. Thus, Gallaway alone and/or combination of Official Notice teach the importance of adding weight element(s) in the rearward of the intersection of the hosel and sole.

The declaration under 37 CFR 1.132 filed on 4/11/03 is insufficient to overcome the rejection of claims 1-27 and the new claims 28-29 based upon reference applied under 35 U.S.C., above. The concept of oval insert and the weight pad in the heel/skirt area are disclosed in Gallaway's invention and also taught by Official Notice, and therefore, the declaration is not sufficient to overcome the prior art rejection as applied above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (703) 305-4559. The examiner can normally be reached on 8:00AM - 4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 873-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Tom Duong
June 26, 2003


Paul T. Sewell
Supervisory Patent Examiner
Group 3700